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Richard C Woodbridge
Woodbridge & Associates
PO Box 592
Princeton, NJ 08542-0592

EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/936,366

Applicant(s)

ROON, MARK VAN

Examiner

Susan Y Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21 and 23-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) 17-21 and 23-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 17-21 and 23-32 are pending for examination; claims 17, 20, 23-27, 29-30 and 32 have been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 27, 29 and 32, the claimed subject matter "the first and second transactions occurring" is lacking of antecedent basis.

As to claims 28, 30 and 31, these claims have the same defect as their base claims 27, 29 and 32 respectively, hence are rejected for the same reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17-21 and 25-32, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,920,847 issued to Kolling et al. (hereinafter referred as Kolling '847).

Claim 17:

Kolling '847 discloses:

a computer system [e.g., the Network Payment system, Figs. 4] enables a party [e.g., the customer C (12), Fig. 4] and counter-party to be efficiently matched , comprising a first computer terminal into which the party inputs details of a potential first financial transaction, a second computer terminal into which the counter-party inputs details of a potential second financial transaction [e.g., see col. 12, lines 1-9], a computer network connecting the first and second terminals [e.g., the Payment Network (102), Fig. 4, connects the Consumer (12) and the Biller (14)]

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Terminals]; in which the first and second transactions relate to the purchase or sale of different kinds of financial property [e.g., the claimed limitation read by the nature of payment network, col. 12, line 1];

Furthermore, the system characterized in there being:

a) a computer program [e.g. the software program in the UBF Computers, col. 21, lines 29-36] that allocates to each of the different kinds of financial property a unique identifier such that each possible combination of kinds of financial property to be bought or sold by parties and counter-parties is uniquely identifiable by a combination identifier derived from the unique identifiers [the BRN, Fig. 5, col. 11, line 17, col. 18, lines 9-22];

b) a computer program [e.g. the software program in the UBF Computers, col. 21, lines 29-36] being arranged to determine a net payment position if both the first and second transactions were to occur and to complete each transaction on the basis of the net payment position [e.g., the Settlement sub-system (104), Fig. 4; col. 12, lines 1-27; col. 19, lines 11-24; Figs. 9-11].

Claim 18:

Kolling '847 further discloses:

There are sever party/counter-party pairs in a connected series of financial transactions such that only by combining all of the connected transactions are all

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of the parties and counter-parties satisfied in whole or part [e.g., see col. 12, lines 1-27].

Claim 19:

Kolling '847 further discloses:

The Internet comprises network connecting the first and second terminals [e.g., the payment Network (102), Fig. 4].

Claim 20:

Kolling '847 further discloses:

The first and second transactions relate to the sale or transfer of different kinds of financial property of a given type, the type being selected from the group consisting of currency, foreign exchange, treasury bills, stocks and shares [e.g., see the Bill Pay Order (122), or the Currency Foreign Exchange (166) processing, Fig. 6 or the customer selected invoice 120, Fig. 7 and associated texts].

Claim 21:

The claimed feature that the financial program is designed to identify and complete transactions in first in first out order is a default nature of the network payment system.

Claim 25:

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Kolling '847 further discloses:

The system comprising a program which is able to calculate combination identifiers of financial property for all possible combinations to be bought and sold and to identify a match where a combination identifier for a combination to be sold equals a combination identifier for a combination to be bought [e.g., col. 11, lines 50-67; col. 16, lines 29-34, Fig. 4 and Fig. 17 and associated texts].

Claim 26:

Kolling '847 further discloses:

The system comprising the amount of financial property available for matching in any given combination is determined by a calculation which involves evaluating the financial properties in that combination in terms of a base currency [e.g., col. 11, lines 50 – col. 12, line 19].

Claim 27:

Kolling '847 discloses:

- using a web browser to defining a foreign exchange requirement [e.g. see col. 12, lines 24-27 of Kolling '847];
- sending the requirement via the internet to a server [e.g., see the Payment Network 102, Fig. 4];
- processing that requirement by identifying one or more matching counter parties using 1) a computer program that allocates to each of the different kinds of foreign exchange a unique identifier such that

each possible combination of kinds of foreign exchange to be bought and sold is uniquely identifiable by a combination identifier derived from the unique identifiers [e.g. the software program in the UBF Computers, col. 21, lines 29-36; the BRN, Fig. 5, col. 11, line 17, col. 18, lines 9-22] ; and 2) a computer program arranged to determine prior to the first and second transactions occurring, a net payment position if both the first and second transactions were to occur and to complete each transaction on the basis of the net payment position [e.g., col. 12, lines 1-27; Figs. 9-11].

Claim 28:

Kolling '847 further discloses:

The foreign currency exchange transaction occurred in a computer system [e.g., Fig(s). 1- 4].

Claim 29:

Kolling '847 further discloses:

A server is programmed to process a foreign currency exchange transaction based on a net payment position between the part and a counter-party [e.g., see the Settlement sub-system (104), Fig. 4; col. 11, lines 50 – col. 12, line 9; col. 19, lines 11-24]. Wherein, the server is program to perform the functions: 1) to allocate to each of the different kinds of foreign exchange a unique identifier such that each possible

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combination of kinds of foreign exchange to be bought and sold is uniquely identifiable by the party and counter-party is uniquely identifiable by a combination identifier derived from the unique identifiers [e.g. the software program in the UBF Computers, col. 21, lines 29-36; the BRN, Fig. 5, col. 11, line 17, col. 18, lines 9-22] ; and 2) to determine prior to the first and second transactions occurring, a net payment position between the party and the counter-party if the transaction were to occur and subsequently to complete the transaction between the party and the counter-party on the basis of the net payment position [e.g., col. 12, lines 1-27; Figs. 9-11].

Claim 30:

Kolling '847 further discloses:

The server is part of the computer based network payment system [e.g. Fig. 4].

Claims 31-32:

These claims recite the same features claimed by the applicant as discussed for claims 17, 27 and 29 above in form of client party [e.g. the Customers (502, 510i), Fig. 17; Fig.(s) 10-19C and associated texts], hence are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,920,847 issued to Kolling et al. (hereinafter referred as Kolling '847) in view of U.S. Patent No. 6,282,522 issued to Davis et al. (hereinafter referred as Davis '522).

Claim 23:

Kolling '847 discloses all of the features claimed by the applicant as discussed for claims 17, 27 and 29 above, he further disclose each unique identifier is an assignment value number in the form of Modulus-10 [e. g. col. 18, lines 9-22], but he fails to teach each unique identifier is an assignment value number in the form 10^N , with N being different for each financial property.

However, the claimed feature read by the unique identifier discloses by Davis '522 [e.g., the currency's exponent for each unique currency, col. 15, lines 40-51].

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Kolling '847 and Davis '522 are common subject matter for managing financial property payment via unique transaction identifier, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modifying the unique transaction identifier (or BRN) of Kolling's with the unique identifier taught by Davis '522, because by doing so, the combined unique transaction identifier will provide further indication of what financial property is being use in the specific transaction and facilitates the financial property exchange.

Claim 24:

The combined system further discloses that the value of combination identifier is calculated by adding the unique identifiers for each financial property in that combination [e.g., Kolling '847: col. 16, lines 7-14; Davis '522: Fig. 12 and associated texts].

Response to Arguments

Applicant's arguments filed on 06/24/2004 have been fully considered but they are not persuasive.

The examiner disagrees with applicant argument that the broadening of the claimed subject matter "currency" to include the boarder class of which it is a member or to use an alternative member of that class, does not effect the examiner's rational for allowability. In response to this argument, the examiner

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points out that because applicant admitted the allowable subject matter is broaden which change the scope of the invention and raise new issues that are subject to rejection based on the prior art as discussed above, thus, the examiner withdraws the allowable subject matters cited on record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is

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571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

December 14, 2004



UYEN LE
PRIMARY EXAMINER